

Appl. No. 10/767,599

Amdt. dated 07/24/2006

Reply to Office action dated: Dec 9, 2005 Mailed: Jan 12, 2006

## **REMARKS/ARGUMENTS**

### **Obviousness (35 USC § 103)**

The Office considers claims 15, 17, 18 and 19 are rejected under 35 U.S.C. 103 as being unpatentable over Watson (US 6,604,840) in view of Yu, (US 6,526,680) The applicant for the following reasons.

- 1) Watson discloses a plurality of LED light sources, while claim 15 only discloses a light source (emphasis added).
- 2) Watson is for use with an image/sign, while claim 15 discloses the use with artwork or a picture (emphasis added). There is a significant difference in illumination of a sign or license plate where the illumination of the sign is for identification of streets, and a license plate is used for identification of a vehicle. The illumination of a picture or artwork is for enjoyment and appreciation.
- 3) The examiner cites that the frame as used in Yu is to evenly illuminate the entire perimeter of the sign. In claim 15 only a single light source is disclosed and there is no requirement for even illumination, just supplemental illumination.

The Office considers claims 1-9 and 11-22 are rejected under 35 U.S.C. 103 as being unpatentable over Watson (US 6,604,840) in view of Sanders, (US 6,568,109) and further in view of Yu, (US 6,526,680).

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The applicant claims the same reasons regarding the rejections for claims 15, 17, 18 and 19 above and argues that claims 1-9 and 11-22 are not taught by Sanders.

In the office action the examiner identifies that in Sanders "The preferred compensation is to make the display lights brighter in daytime or larger amounts of ambient light to maintain visibility and to make it dimmer at night so that it does not glare. See column 3, lines (sic) 48-64)." While this is identified as the preferred embodiment there are no embodiments that identify the illumination method identified in the pending application, namely the limitations in independent claims 1, 8 and 15 that has the limitation of "provide illumination onto the artwork or picture in an inverse proportional relationship to the amount of ambient light detected by the variable power control mechanism to supplement ambient light."

In Sanders the ambient light sensor does not supplement the ambient light that is external to the housing. Sander does just the opposite. As the ambient light increases the intensity is increased as described in the disclosure (Col 3 Lines 55-58) and in independent claims 1 and 4. There is no disclosure in Sanders that the compensation for ambient light is to increase (supplement) the light intensity as the ambient light decreases.

The pending application further distinguishes itself from any of the cited prior art because it provides at least one lighting element located on only one side of the artwork or picture while Watson provides a "plurality of light sources" (abstract).

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. (emphasis added)

While all three of the cited references involve illumination on, around or of a flat surface, there is no teaching, suggestion or motivation in the identified prior art to combine the two or more of the patents as required under 103(a). The problem being solved by the Watson is to illuminate a street sign. The problem being solved by Yu is to illuminate a license plate. The problem being solved by Sanders is to illuminate a house address. They each provide solutions to their problems, but there is no motivation explicitly or implicitly to combine these reference as taught within these references that is sufficient to

Words does not equate to a finding of obviousness. "[T]he inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the inventions as a whole for which patentability is claimed." *Hartness*

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*International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1832 (Fed. Cir. 1987).

Moreover, even patentable claims are made up of known elements. "That all elements of an invention may have been old is not unusual, and indeed, irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements." *American Medical Systems Inc. v. Medical Engineering Corp.*, 6 F.3d 1523, 28 USPQ2d 1321 (Fed. Cir. 1993).

The prior art must suggest the desirability to combine. "[T]he questions is not simply whether the prior art 'teaches' the particular element of the invention, but whether it would 'suggest the desirability', and thus the obviousness, of making the combination." *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F.2d 1490, 1498, 1 USPQ2d 1337, 1343 (Fed. Cir. 1986). In short, there is no suggestion that would lead one to combine the references and limitations as identified by the examiner.

It is noted by the applicant that PAIR indicates that the claim amendments from the last reply dated and received by the USPTO on 02-09-2006 have not entered. This was determined by the applicant when viewing the image file wrapper in PAIR. There is no explanation in PAIR regarding this action and the final office action from the examiner is mute in regards to this action yet a final office action has been issued. Based upon the lack of entry of the last amendments and the lack of notification regarding this action, the applicant feels that the final rejection should be withdrawn until a proper evaluation of the last reply has been made.

In the last office action the examiner failed to address added claims 23-26, and the applicant clarification regarding the patentability of these claims.

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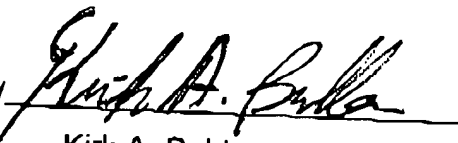
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Claims 2-4, 6, 7, 11-14, 16, 18-20, 22-26 are not obvious based upon the changes made to independent claims 1, 8, 15 and by virtue of their dependence on independent claims 1 8, and 15.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,  
BUHLER & ASSOCIATES

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